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# BEFORE THE BOARD OF PATENT APPEALS
## AND INTERFERENCES

Application Number: 09/756,788
Filing Date: January 10, 2001
Appellant(s): SCROGGIE ET AL.

———————————
Richard Neifield
For Appellant

## EXAMINER'S ANSWER

This is in response to the Appeal brief, filed on October 23, 2008, appealing from the
Office Action mailed September 17, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The related appeals, interferences and judicial proceedings known to the Examiner,
which may be related to, directly affect or be directly affected by or have a bearing on the
Board's decision in the pending appeal are listed by the Appellant on pages 1-3 of the Appeal
Brief:

**(3) Status of Claims**

The statement of the status of claims contained in the Brief is partially correct. A correct
statement of the status of the claims is as follows:

Claims 1-31 are canceled.

Claims 32-91 were rejected and subsequently amended, but the amendment was
thereafter canceled by the Appellant and never considered by the Examiner.

New claims 92-97 were not considered or rejected.

The version of the claims in the Appendix represents the amended version, which was
canceled by the Appellant and never considered by the Examiner.

**The version of claims 32-91, filed on April 17, 2003, pending at the time the Non-**
**Final Action was issued is herein being appealed.**

See below for more details.

There is no final Action recorded in this Application at this time. The claims were amended by a 37 CFR 1.111 reply, filed on September 29, 2008 in response to the pending Office Action, and the 1.111 response or reply was canceled by the Appellant, in the January 30, 2009 reply to the defective Brief, in favor of the Appeal Brief filed on October 23, 2008. **And the canceled claims are currently featured in the Appendix section as pending claims**. In short, a claim amendment was filed after the pending Non-Final Action was issued and the claim amendment was subsequently canceled by the Appellant, never entered by the Office and considered by the Examiner. See below for more information.

[On September 17, 2008, the Office mailed a Non-Final Action to the Appellant. On September 29, 2008, the Appellant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before, the Examiner issued a response to the 1.111 reply, Appellant had filed on October 23, 2008 a Notice of Appeal together with an Appeal Brief. In response, the Examiner had asked the Appellant to either render the 1.111 reply null and void to thereby proceed with  the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered instead. By so doing, the Examiner had issued a "defective Appeal Brief" while concluding that **the Application was not in condition for Appeal** (in view of the confusion).

The Appellant, on January 30, 2009, had filed a reply in the form of a petition to the "defective Appeal Brief" and correctly argued that the Application was in condition for Appeal for the claims had been rejected many times (more than twice) and agreed to "render the 1.111 reply null and void" or simply cancel the 1.111 reply to thereby proceed with the Appeal Brief filed on October 23, 2008 (See page 4 of the said response-3rd paragraph). Furthermore, it

appears that the Appellant had elected to rather proceed with the old Appeal Brief, filed on

October 17, 2006, since the last Office Action was a response to the filing of the old Appeal

Brief. The rest of the Appellant's remarks in the petition is beyond the scope of the Examiner's

Answer. Additionally, the **petition was granted in part, on April 10, 2009,** agreeing with the

Appellant that the Application was indeed in condition for Appeal and the Examiner will proceed

with the Examiner's Answer as shown below.]

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

Claims 32-92 contain(s) substantial errors as presented in the Appendix to the brief:

Claims 32-91 were rejected and subsequently amended, but the amendment was

thereafter canceled by the Appellant and never considered by the Examiner.

Amended independent claims 32, 38, 44, 49, 54, 57 and 58 as featured in the Appendix

were never considered by the Examiner.

New claims 92-97 were not considered or rejected.

The version of the claims in the Appendix, namely claims 32, 38, 44, 49, 54, 57 and 58, represents the amended version, which was canceled by the Appellant and never considered by the Examiner.

**The version of claims 32-91, filed on April 17, 2003, pending at the time the Non-Final Action was issued is herein being appealed and a copy of the claims is included as part of the file.**

(See the status of the claims above).

Accordingly, a copy of the claims, being appealed here, considered at the time the pending Non-Final Action was issued is include as part of the file for review.

**(8) Evidence Relied Upon**

| | | |
|---|---|---|
| 6,321,208 | Barnett | 11-2001 |
| 5,793,972 | Shane | 8-1998 |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 57 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter and to a non-functional and non-descriptive material. Indeed, claim 57 recites a web site comprising a personal database, a purchase history database and so on. However, a web site by itself is a collection of web pages, i.e. data per se, which does not

necessarily imply or involve a web server or a database. To this end, the recited web site is data

per se, which does not belong to any well defined statutory class (.e.g. a method, a system, an

apparatus, an article of manufacture….).


> ### *The following is a quotation of the second paragraph of 35 U.S.C. 112:*
>
> The specification shall conclude with one or more claims particularly pointing out
> and distinctly claiming the subject matter, which the Patent Owner regards as his
> invention.

Claims 32, 38, 44, 50 and 54 (including their dependent claims) are rejected under

35 USC 112, second paragraph as being indefinite for reciting the auxiliary verb "can",

which creates some uncertainty therein.

Claim 57 is rejected under 35 USC 112, second paragraph as being confusing for

reciting a web site or data per se in the preamble, while the body of the claim contains

structure or means plus function.


**The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all**

**obviousness rejections set forth in this Office action:**

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains.  Patentability shall not be negatived
> by the manner in which the invention was made.

This application currently names joint inventors.  In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary.  Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 32-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Barnett, 6,321,208 in view of Shane, US Patent 5,793,972.**

As per claims 32, 50, 58, 38, 44 and 54, Barnett discloses a system for distributing in an

interactive manner over a computer network or the Internet by an online service provider 2 of

fig. 1 (via a web site) electronic coupons (Virtual coupons or purchase incentives), received from

one or more coupon issuers 14 or multiple sources (manufacturers or retailers) through a coupon

distributor 16, to registered users using remote computers 6 of fig. 1 wherein a central repository

or database file 40 of fig. 6 associated with the online service provider 2 stores electronic coupon

packages or purchasing incentives and a database file 42 (consumer database file or personal

database) stores users' demographic data or profile data (such as address, income, name, e-mail

address, unique user code and other information, etc.,), provided by the users during an online

registration process with the online service provider 2 (via the web site) and survey responses

given by the users during ongoing online demographic inquiries. The consumer database file 42

of fig, 6, coupled to the online service provider 2 (web site or server), also contains users' buying

history profile (i.e. online/offline shopping activity) used in conjunction with the users'

demographic data, stored therein, to prepare targeted coupon packages for the individual users,

wherein the coupon packages are recorded in database file 40 related to the online service

provider 2 (web site or server). Upon redeeming a printed or downloaded coupon, the user will

end up buying or purchasing an issuer's or a manufacturer's product or service. **See abstract;
col. 8: 14-22; col. 13: 50-63; col. 8: 6-51; fig. 6.**

In an alternative embodiment of the present system, the user is provided with a visual or
auditory stimulus or cue (a notice or a reminder) to suggest an access of the electronic coupon
distribution system or online service provider 2 web site. Referring to FIG. 7, a message or logo
may be included along with an advertising material normally provided on television, in the
newspapers and the like. This will indicate to a user that he should access the online service
provider 2 web site in order to obtain coupon data related to the advertised product. The
availability of the coupon could be time-sensitive, which would provide further incentive to the
user to use the system in a prompt and efficient manner. When radio media are used, a tonal or
spoken cue may be included during the advertising message to accomplish the same result (fig.
7; col. 13: 11-23).

**As per claims <u>32, 50 and 58</u>, although Barnett discloses that a user's demographic
information including the user's identifying data, e.g. unique code, e-mail address and so
on, and the user's buying history (online/offline) is stored in database file 42 of fig. 6
(consumer database) and that the user's requested coupon data are electronically
transmitted to the user's computer 6 of fig. 1 where they can be printed, however, <u>Barnett
does not expressly teach a consumer purchase history database separately storing the
buying history (online/offline), nor does he mention e-mailing coupon data or purchase
incentives to the user for subsequent printing.</u>**

However, Shane discloses a system for providing an interactive response to direct mail
programs comprises a recipient database, a mail generator, and a web server computer (first

device) operationally connected through the Internet to remote computers (second devices) accessible by direct mail recipients or screened users. The recipient database stores data records containing addressing information **such as the name, mail, fax or e-mail address, and a unique personal identification code or PIN number for each direct mail recipient** (recipient database stores mailing list parameters). The user's data records or personal data are used to generate a personalized web page for the user, where promotional information can be displayed to the user. The mail generator retrieves recipient data from the database and generates a multiplicity of targeted direct mail pieces **(notices)** each displaying the name, address, and a uniform resource locator or URL containing the personal identification code for a screened or targeted recipient. **The targeted or responding recipient accesses the web server (first device) or central computer by entering the uniform resource locator or URL associated with his personalized web page and displayed on the received direct mail piece or mailer (advisory message or notices), mailed via the post office or e-mailed to the targeted recipient, into a local web browser outputted on his remote computer or second device (logging step)**. The web server computer retrieves recipient data from the recipient database correlated to the personal identification code or PIN contained in the uniform resource locator and uses this recipient data to create a unique interactive web page, where the recipient or respondent views personal messages or ads (promotions) directed to his attention. It should further be understood that the personalized web page data are stored along with the user's identifier or PIN and personal data in a database and the web page data, i.e. URL or web page address, are sent to the user via e-mail to subsequently access his personalized web page, displaying the user's name, and view targeted promotions displayed thereon in accordance with the user's profile. It is

further understood that the user can print the received or incoming e-mail message if necessary using a printing device coupled to his computer (See abstract; figs. 1-4E; col. 2: 23 to col. 3: 10).

**Moreover, it is common practice in the art to store different type of information in different and separate databases (database files) respectively and to give respective users and/or operators access rights to the stored information. For example, a system administrator may store accounting data, including account receivables, in a one database or database file and give an operator access rights to the accounting data stored therein, while marketing data, including customers' responses to surveys, purchases or purchase data, etc., may be recorded in a separate database or database file operated by one or more authorized employees, with appropriate access rights, dealing with marketing and promotion issues, wherein the databases maybe coupled to a one more servers.**

**Finally, storing the user's demographic information including the user's identifying data, e.g. unique code, e-mail address and so on, and the user's buying history (online/offline shopping activity) in a single or integrated database file 42 of fig. 6 or into two separate database files respectively is a matter of desires or choice, which does not impact the functionality or utility of the method or system by which targeted or customized purchase incentives or coupon packages are generated and provided to the specific user. The above conclusion is well within the level of skills of an ordinary artisan.**

Thus, it would have been obvious to an ordinary skilled artisan, implementing the system of Barnett at the time of the invention, to incorporate the above disclosure into the system of Barnett so as to record **the user's demographic information including the user's identifying data, e.g. unique code, e-mail address and so on, in a database file 42 of fig. 6 and the user's**

**buying history (online/offline shopping activity) in** another and separate database or database

file and to enable two different and independent operators or authorized employees, with

appropriate rights, to access the respective databases or database files to separately maintain and

analyze the data contained therein in order to generate individual user's profile information,

based on the collected demographic data and buying history respectively, which is used to

produce a merged or combined user's profile useful in crafting targeted coupon data or purchase

incentives that are sent to the specific user via e-mail, wherein the content of the e-mail is

subsequently printed at the user's computer 6 of fig. 1 using a printing device coupled thereto,

thereby ensuring that the user's (combined) profile, generated from data contained in the

database files (consumer database and consumer purchase history database respectively) and

used by the issuers or sources to prepare customized coupon packages or purchase incentives e-

mailed to the specific user, is accurate  and independently produced by two different and

independent operators or authorized employees before the result of the independent analyses is

merged or combined to form the user's profile, while pro-actively targeting the user by e-mailing

customized coupon data packages to the user, based on the combined profile, without the user's

intervention or without the user visiting the online service provider 2 web site to view or request

the coupon data packages therefrom.


        **As per claims 38, 44 and 54, although Barnett discloses that a user's demographic**

**information including the user's identifying data, e.g. unique code, e-mail address and so**

**on, and the user's buying history (online/offline) is stored in database file 42 of fig. 6**

**(consumer database) and that the user is provided with visual or auditory stimulus or cue**

**(notice or reminder) to access the online service provider 2 web site to view or download**

**time-sensitive coupon packages used in purchasing a manufacturer's product(s) (i.e.**

**providing notices to the user to purchase a manufacturer's product upon redeeming an**

**associated coupon), Barnett does not expressly teach a consumer purchase history database**

**separately storing the buying history (online/offline), nor does he mention transmitting e-**

**mail notices to the user to visit the online service provider 2 web site.**

However, Shane discloses a system for providing an interactive response to direct mail

programs comprises a recipient database, a mail generator, and a web server computer (first

device) operationally connected through the Internet to remote computers (second devices)

accessible by direct mail recipients or screened users. The recipient database stores data records

containing addressing information **such as the name, mail, fax or e-mail address, and a**

**unique personal identification code or PIN number for each direct mail recipient** (recipient

database stores mailing list parameters). The user's data records or personal data are used to

generate a personalized web page for the user, where promotional information can be displayed

to the user. The mail generator retrieves recipient data from the database and generates a

multiplicity of targeted direct mail pieces **(notices)** each displaying the name, address, and a

uniform resource locator or URL containing the personal identification code for a screened or

targeted recipient. **The targeted or responding recipient accesses the web server (first device)**

**or central computer by entering the uniform resource locator or URL associated with his**

**personalized web page and displayed on the received direct mail piece or mailer (advisory**

**message or notices), mailed via the post office or e-mailed to the targeted recipient, into a**

**local web browser outputted on his remote computer or second device (logging step). The**

web server computer retrieves recipient data from the recipient database correlated to the

personal identification code or PIN contained in the uniform resource locator and uses this

recipient data to create a unique interactive web page, where the recipient or respondent views

personal messages or ads (promotions) directed to his attention. It should further be understood

that the personalized web page data are stored along with the user's identifier or PIN and

personal data in a database and the web page data, i.e. URL or web page address, are sent to the

user via e-mail to subsequently access his personalized web page, displaying the user's name,

and view targeted promotions displayed thereon in accordance with the user's profile. It is

further understood that the user can print the received or incoming e-mail message if necessary

using a printing device coupled to his computer (See abstract; figs. 1-4E; col. 2: 23 to col. 3: 10).

**Moreover, it is common practice in the art to store different type of information in
different and separate databases (database files) respectively and to give respective users
and/or operators access rights to the stored information. For example, a system
administrator may store accounting data, including account receivables, in a one database
or database file and give an operator access rights to the accounting data stored therein,
while marketing data, including customers' responses to surveys, purchases or purchase
data, etc., may be recorded in a separate database or database file operated by one or more
authorized employees, with appropriate access rights, dealing with marketing and
promotion issues, wherein the databases maybe coupled to a one more servers.**

**Finally, storing the user's demographic information including the user's identifying
data, e.g. unique code, e-mail address and so on, and the user's buying history
(online/offline shopping activity) in a single or integrated database file 42 of fig. 6 or into**

**two separate database files respectively is a matter of desires or choice, which does not**

**impact the functionality or utility of the method or system by which targeted or customized**

**purchase incentives or coupon packages are generated and provided to the specific user.**

**The above conclusion is well within the level of skills of an ordinary artisan.**

Thus, it would have been obvious to an ordinary skilled artisan, implementing the system

of Barnett at the time of the invention, to incorporate the above disclosure into the system of

Barnett so as to record **the user's demographic information including the user's identifying**

**data, e.g. unique code, e-mail address and so on, in a database file 42 of fig. 6 and the user's**

**buying history (online/offline shopping activity) in** another and separate database or database

file and to enable two different and independent operators or authorized employees, with

appropriate rights, to access the respective databases or database files to separately maintain and

analyze the data contained therein in order to generate individual user's profile information,

based on the collected demographic data and buying history respectively, which is used to

produce a merged or combined user's profile useful in crafting targeted coupon data or purchase

incentives that can be viewed or downloaded by the user upon visiting the online service

provider 2 web site subsequent to receiving e-mail notices to access the online service provider 2

web site, thereby ensuring that the user's (combined) profile, generated from data contained in

the database files (consumer database and consumer purchase history database respectively) and

used by the issuers or sources to prepare customized coupon packages or purchase incentives

viewed or downloaded by the specific user upon visiting the online service provider 2 web site

subsequent to receiving an e-mail notice/reminder in addition to other visual cues   to do so, is

accurate and independently produced by two different and independent operators or authorized

employees before the result of the independent analyses is merged or combined to form the

user's profile, while pro-actively targeting the user by sending him e-mailing notices/reminders,

in addition to other visual cues, to access the said web site to view or download generated

customized coupon data packages, based on the combined profile, and while rendering the

coupon distribution and redemption system more effective by encouraging the user to timely

visit the web site and take advantage of time-sensitive incentives stored therein.


    As per claim 57, Barnett discloses a system for distributing in an interactive manner over

a computer network or the Internet by an online service provider 2 of fig. 1 (via a web site)

electronic coupons (Virtual coupons or purchase incentives), received from one or more coupon

issuers 14 or multiple sources (manufacturers or retailers) through a coupon distributor 16, to

registered users using remote computers 6 of fig. 1 wherein a central repository or database file

40 of fig. 6 associated with the online service provider 2 stores electronic coupon packages or

purchasing incentives and a database file 42 (consumer database file or personal database) stores

users' demographic data or profile data (such as address, income, name, e-mail address, unique

user code and other information, etc.,), provided by the users during an online registration

process with the online service provider 2 (via the web site) and survey responses given by the

users during ongoing online demographic inquiries. The consumer database file 42 of fig, 6,

coupled to the online service provider 2 (web site or server), also contains users' buying history

profile (i.e. online/offline shopping activity) used in conjunction with the users' demographic

data, stored therein, to prepare targeted coupon packages for the individual users, wherein the

coupon packages are recorded in database file 40 related to the online service provider 2 (web

site or server). **See abstract; col. 8: 14-22; col. 13: 50-63; col. 8: 6-51; fig. 6.** First, a user

initially visits the online service provider 2 web site and downloads or accesses generic or

untargeted electronic coupons or coupon data stored in database file 40 associated with the

online service provider 2 and the user's demographic data and coupon selection data are

collected during the initial visit (prompting the user to provide personal data during a registration

process) and are used to target specific coupon data packages for subsequently downloading by

the user. Here, those targeted coupon data packages generated for the user or specific user are

stored in the database 40 of the online service provider 2 along with uniquely created user-

specific identification indicia (identification code, authorization number, password or unique

identifier) uniquely identifying the user or customer using or participating in the online coupon

distribution system (col. 7: 55 to col. 8: 5; Claim 1 of the current reference).

     Once the user joins the online coupon distribution system subsequent to the registration

process, where the user is prompted to provide demographic data, during the initial visit, then the

user can connect or access or log into, by inputting via a keyboard his identification number or

user-specific ID (password) and/or login name, the online service provider 2 system having an

associated web site where the said user can download from database 40 or central repository of

the online service provider 2 targeted coupon data, received from the merchant or coupon issuer

14 (company, retailer, vendor or manufacturer) via the coupon distributor 16 and specifically

directed to the user's attention and in accordance with the user's profile, to his personal computer

6 where the coupon data can be stored in a local database 30 (fig. 2), coupled to computer 6, or

used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to

the user's computer 6 (the user downloads the targeted coupon data from the online service

provider 2 to his computer 6 having, among other things, a coupon management program 32 or

coupon organizer for the management of the downloaded coupon data). Using the coupon

management software 32, the user can generate virtual printable images of coupons from the

downloaded coupon data and create associated shopping lists, wherein the generated virtual

printable images of coupons can be stored locally in the coupon database 30 or in the online

central repository 40 of the online service provider 2 for later retrieval and use (fig. 2; col. 5: 15-

21; col. 8: 52 to col. 9: 45) and (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11; col. 9: 33-

52).

       In one embodiment, the locally generated virtual printable images of coupons are used to

obtain hard copies or printed coupons. Subsequently, one or more printed coupons are presented

for redemption in the normal or conventional fashion by the specific user or customer when

shopping at a desired retailer. Furthermore, the user may be conducting a business transaction

with an online shopping mall, which is connected over the Internet to the online service provider

2 so as to detect in the customer's order any matching UPC code associated with a user's

discount coupon, stored in database 40 of the online service provider 2, and if a matching UPC

code is found, then the value of the coupon is determined in real-time and a price reduction is

automatically applied to the customer's order (or the user is provided with the option to conduct

an online transaction and if the user accepts this option, then a generated coupon stored in the

service provider 2 database 40 and associated with the identified user can be applied to the user

transaction if the required item is purchased). Moreover, the coupon data can be electronically

forwarded by the user directly to a designated retail store 10 for subsequent use by the user

during a redemption process threat. In this case, it should be recognized that the user should be

properly identified at the POS, since the user does not carry the printed coupon with him, before

the redemption can be performed using any commonly acceptable identification means or indicia

such as a picture ID like a driver's license or conventional payment instruments like a credit card

or debit card, etc. (Col. 11: 29-43).

In another embodiment, the entire coupon distribution can be conducted online, thereby

eliminating the need for the user to print the coupon or to locally store downloaded coupon data.

Here, the functions of the online service provider 2 are carried online on the Internet, wherein the

identified user may access the coupon data repository (generated coupon data stored in D/B 40 of

fig. 6) by logging into the web site related to the online service provider 2. The downloaded or

local coupon management routine 32 functions are encoded with a unique user's identification

number, which may be for example, the user's e-mail address. When the user requests coupon

data packages from the data repository or D/B 40, the user's identification number is encrypted

and sent to the web site related to online service provider 2 along with the request. Appropriate

routines are implemented at the said web site to decrypt the user's identification number and

compare it against a list of valid members in order to ensure the validity of the user. (See

abstract; figs. 1-6 and 9; col. 4: 40 to col. 5: 61; col. 6: 65 to col. 7: 55; col. 8: 22-48; col. 10: 1-

16; col. 10: 24-30; col. 10: 50-56; col. 11: 11-43; col. 13: 50-62).

In any event, following a redemption process, redeemed coupon data are transmitted by

the desired retailer or POS, especially a brick and mortar store, to a coupon redemption center 13

where they are electronically read and the user-specific data are recorded in a coupon redemption

database (D/B) 12. Additionally, the user's transaction data including the redeemed coupon data

(redemption data or coupon usage) are provided to the coupon issuers 14 (company, retailer or

manufacturer) and coupon distributors 16 of fig. 1 for integration into further marketing analysis

in order to provide further targeted coupon packages to the customer. In order words, the coupon

issuers 14 or merchants (or coupon distributor 16) of fig. 1 utilize the user-specific data

**(coupons deleted, coupon printed and demographic data, user's buying or shopping**

**history, number of times coupons were viewed or requested or selected) along with the**

**redemption data to generate or compile subsequent coupon packages targeted specifically**

**or directed to the user's attention (using redemption data and online demographic**

**inquiries to update the user's virtual coupons or electronic coupons stored in database 40)**

(See abstract; col. 5: 23-34; col. 6: 58-65; col. 7: 12-20; col. 7: 36-55; col. 8: 14-21; col. 12: 26-

37).

Additionally, the online service provider 2 has means to determine how many times a

particular coupon was selected or viewed or requested. Coupon usage data and user's responses

to online demographic inquiries are used to provide a coupon of a higher value to the user (col.

13: 24-35).

Finally, and in summary, Barnett discloses an online coupon distribution method or

system for enabling a user to view and print at a remote terminal user-specific coupons based on

a user profile, the method comprising the steps of:

  (a) storing in a storage device at a central location electronic coupon information pertaining to

a group of coupons available;

  (b) receiving a request from a user for access to stored coupon information;

  (c) determining if the user is a registered user, and if the user is not registered:

i) transmitting a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location;

ii) receiving and storing a user profile at the central location; and

iii) downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information;

if the user is registered, accessing the stored user profile;

**(d) viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information;**

(e) receiving at the central location a request to transmit to the remote terminal at least one coupon data file, the coupon data file corresponding to a user selected coupon, the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user; and

(f) transmitting to the remote terminal the at least one coupon data file to enable the user to print a coupon using the coupon data management software module.

See claim 1 of the current reference.

**(Col. 12: 26 to col. 13: 63; col. 10: 15 to col. 11: 11; col. 11: 48-57; col. 9: 35-53; col. 8: 14-21; col. 7: 56 to col. 8: 5; col. 13: 11-35).**

Please consider the entire reference.

As per claim 57, Barnett does not expressly disclose using the user's personal data, such as demographic data, to generate a unique personal web page for the user with the user specific display, sending an e-mail to the user to notify him of new incentives and updating the web page

However, Shane discloses a system for providing an interactive response to direct mail programs comprises a recipient database, a mail generator, and a web server computer (first device) operationally connected through the Internet to remote computers (second devices) accessible by direct mail recipients or screened users. The recipient database stores data records containing addressing information such as the name, mail, fax or e-mail address, and a unique personal identification code or PIN number for each direct mail recipient (recipient database stores mailing list parameters). **The user's data records or personal data are used to generate a personalized web page for the user, where promotional information can be displayed to the user**. The mail generator retrieves recipient data from the database and generates a multiplicity of targeted direct mail pieces each displaying the name, address, and a uniform resource locator or URL containing the personal identification code for a screened or targeted recipient. The targeted or responding recipient accesses the web server (first device) or central computer by entering the uniform resource locator or URL associated with his personalized web page and displayed on the received direct mail **piece or mailer (advisory message),** mailed via the post office or e-mailed to the targeted recipient, into a local web browser outputted on his remote computer or second device (logging step). The web server computer retrieves recipient data from the recipient database correlated to the personal identification code or PIN contained in

the uniform resource locator and uses this recipient data to create a unique interactive web page, where the recipient or respondent views personal messages or ads (promotions) directed to his attention. It should further be understood that the personalized web page data are stored along with the user's identifier or PIN personal data in a database and the web page data, i.e. URL or web page address, are sent to the user via e-mail to subsequently access his personalized web page, displaying the user's name, and view targeted promotions displayed thereon in accordance with the user's profile (See abstract; figs. 1-4E; col. 2: 23 to col. 3: 10).

Here, recipient database 12 stores recipient data records 22 containing recipient addressing information, such as the recipient's name and address and a unique personal identification code for each intended direct mail recipient. Typically the recipient data (mailing list) contained in the recipient data records 22 is obtained from a mailing list broker and entered or stored into the recipient database 12. **The recipient database 12 may also include demographic and tracking information for each recipient** (col. 3: 64 to col.4: 5).

Further, mail generator 14, typically located in a lettershop, is electronically coupled to recipient database 12 so as to be capable of retrieving the recipient data for each intended or targeted (via a screening or filtering process) direct mail recipient or user. Preferably, mail generator 14 of fig. 1 comprises a computer system 24 including a printer 25 for printing direct mail pieces 26 displaying thereon the name, address and uniform resource locator (or URL related to a web site) containing a unique personal identification code, for each intended recipient. Mail generator 14 also typically addresses and prepares direct pieces or mailers 26 for mailing through a postal system 28, which delivers mail pieces 26 to a plurality of locations 29, typically the home or office of each targeted or screened recipient (col. 4: 6-19).

In short, Shane discloses in fig. 4, the steps (of the method 100) carried out by apparatus 10. An advertiser (user) obtains one or more mailing lists from a list broker (by leasing or purchasing the mailing lists), wherein the mailing lists (raw data) are sent to a data house, along with any in-house lists and suppression lists that the advertiser has previously generated (Block 102). The data contained on the mailing and in-house lists are processed or filtered to eliminate duplicates and to prevent mail from being sent to certain individuals or addresses on the suppression lists, which the advertiser has previously determined would be inappropriate, to generate a recipient database 12 (screening the mailing lists to eliminate duplicate names or to prevent delivery to certain recipients' in a suppression list based at least on their addresses or locations, etc -Block 104) (using a modified or screened mailing list of recipients to send the mailing pieces to). In a typical direct mailing, the direct mail pieces 26 would then be printed by merging a pre-prepared form letter with data from the mailing lists, and the direct mail pieces or mailers 26 would be prepared for mailing and deposited with the post office 28. It is herein contemplated that the user's web page is constantly updated with information or advertising data provided by the advertisers (col. 5: 63 to col. 6: 11).

See abstract; figs. 1-4; col. 2: 22 to col. 3: 32.

Furthermore, the creation of a private (personal) home page or web page is well documented in the art at the time the present invention was recorded.

Therefore, an ordinary skilled artisan, implementing the Barnett's system, would have been motivated at the time of the invention, without reading the present specification, to incorporate the personalized web page of Shane into the targeted coupon distribution of Barnett so as to use the user's personal information, such as demographic data, to generate a

personalized web page, having a specific URL or web address, for the user, to store the user's

web page data along with the user's identifier or code in a database, send an advisory message or

an e-mail along with the web page unique address to the user inviting him to visit his personal

web page, displaying his name in a personal greeting, to view newly targeted generated coupons

or purchase incentives that will be displayed on the user's personalized web page (private home

page), thereby rendering the targeted coupon distribution system more personal or more

appealing to the user by displaying targeted generated coupons directed to the user's attention,

contingent upon the user's demographics, user's coupon usage data and historical buying, on the

user's personal web page or private home page or customized interface when the user visits the

private home page or web page by inputting into a local browser address field the unique web

page URL or web address featured in the e-mail notification sent to the user, while becoming

more pro-active and effective by transmitting an invitation to the user to visit his personal web

page to view targeted or customized coupons or purchase incentives, that can be consumed

immediately or in real-time, once they are being generated rather than passively waiting for the

user to visit the online service provider 2 web site to browse, request, view, select and print

targeted coupons displayed thereon, especially when the generated coupons carry or have a short

expiration date.

As per claims 33-37, 39-43, 45-49, 51-53, 55-56, 59-91, Barnett discloses, among other

things, a system for distributing in an interactive manner over a computer network or the Internet

by an online service provider 2 of fig. 1 (via a web site) electronic coupons (Virtual coupons or

purchase incentives), received from one or more coupon issuers 14 or multiple sources

(manufacturers or retailers) through a coupon distributor 16, to registered users using remote

computers 6 of fig. 1 wherein a central repository or database file 40 of fig. 6 associated with the

online service provider 2 stores electronic coupon packages or purchasing incentives and a

database file 42 (consumer database file) stores users' demographic data or profile data (such as

address, income, name, e-mail address, unique user code and other information, etc.,), provided

by the users during an online registration process with the online service provider 2 (via the web

site) and survey responses given by the users during ongoing online demographic inquiries. The

consumer database file 42 of fig. 6, coupled to the online service provider 2 (web site or server),

also contains users' buying history profile (i.e. online/offline shopping activity) used in

conjunction with the users' demographic data, stored therein, to prepare targeted coupon

packages for the individual users, wherein the coupon packages are recorded in database file 40

related to the online service provider 2 (web site or server). **See abstract; col. 8: 14-22; col. 13:**

**50-63; col. 8: 6-51; fig. 6.**

        In an alternative embodiment of the present system, the user is provided with a visual or

auditory stimulus or cue (a notice or a reminder) to suggest an access of the electronic coupon

distribution system or online service provider 2 web site. Referring to FIG. 7, a message or logo

may be included along with an advertising material normally provided on television, in the

newspapers and the like. This will indicate to a user that he should access the online service

provider 2 web site in order to obtain coupon data related to the advertised product. The

availability of the coupon could be time-sensitive, which would provide further incentive to the

user to use the system in a prompt and efficient manner. When radio media are used, a tonal or

spoken cue may be included during the advertising message to accomplish the same result (fig.

7; col. 13: 11-23).

First, a user initially visits the online service provider 2 web site and downloads or

accesses generic or untargeted electronic coupons or coupon data stored in database file 40

associated with the online service provider 2 and the user's demographic data and coupon

selection data are collected during the initial visit (prompting the user to provide personal data

during a registration process) and are used to target specific coupon data packages for

subsequently downloading by the user. Here, those targeted coupon data packages generated for

the user or specific user are stored in the database 40 of the online service provider 2 along with

uniquely created user-specific identification indicia (identification code, authorization number,

password or unique identifier) uniquely identifying the user or customer using or participating in

the online coupon distribution system (col. 7: 55 to col. 8: 5; Claim 1 of the current reference).

Once the user joins the online coupon distribution system subsequent to the registration

process, where the user is prompted to provide demographic data, during the initial visit, then the

user can connect or access or log into, by inputting via a keyboard his identification number or

user-specific ID (password) and/or login name, the online service provider 2 system having an

associated web site where the said user can download from database 40 or central repository of

the online service provider 2 targeted coupon data, received from the merchant or coupon issuer

14 (company, retailer, vendor or manufacturer) via the coupon distributor 16 and specifically

directed to the user's attention and in accordance with the user's profile, to his personal computer

6 where the coupon data can be stored in a local database 30 (fig. 2), coupled to computer 6, or

used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to

the user's computer 6 (the user downloads the targeted coupon data from the online service

provider 2 to his computer 6 having, among other things, a coupon management program 32 or

coupon organizer for the management of the downloaded coupon data). Using the coupon

management software 32, the user can generate virtual printable images of coupons from the

downloaded coupon data and create associated shopping lists, wherein the generated virtual

printable images of coupons can be stored locally in the coupon database 30 or in the online

central repository 40 of the online service provider 2 for later retrieval and use (fig. 2; col. 5: 15-

21; col. 8: 52 to col. 9: 45) and (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11; col. 9: 33-

52).

        In one embodiment, the locally generated virtual printable images of coupons are used to

obtain hard copies or printed coupons. Subsequently, one or more printed coupons are presented

for redemption in the normal or conventional fashion by the specific user or customer when

shopping at a desired retailer. Furthermore, the user may be conducting a business transaction

with an online shopping mall, which is connected over the Internet to the online service provider

2 so as to detect in the customer's order any matching UPC code associated with a user's

discount coupon, stored in database 40 of the online service provider 2, and if a matching UPC

code is found, then the value of the coupon is determined in real-time and a price reduction is

automatically applied to the customer's order (or the user is provided with the option to conduct

an online transaction and if the user accepts this option, then a generated coupon stored in the

service provider 2 database 40 and associated with the identified user can be applied to the user

transaction if the required item is purchased). Moreover, the coupon data can be electronically

forwarded by the user directly to a designated retail store 10 for subsequent use by the user

during a redemption process thereat. In this case, it should be recognized that the user should be

properly identified at the POS, since the user does not carry the printed coupon with him, before

the redemption can be performed using any commonly acceptable identification means or indicia

such as a picture ID like a driver's license or conventional payment instruments like a credit card

or debit card, etc. (Col. 11: 29-43).

In another embodiment, the entire coupon distribution can be conducted online, thereby

eliminating the need for the user to print the coupon or to locally store downloaded coupon data.

Here, the functions of the online service provider 2 are carried online on the Internet, wherein the

identified user may access the coupon data repository (generated coupon data stored in D/B 40 of

fig. 6) by logging into the web site related to the online service provider 2. The downloaded or

local coupon management routine 32 functions are encoded with a unique user's identification

number, which may be for example, the user's e-mail address. When the user requests coupon

data packages from the data repository or D/B 40, the user's identification number is encrypted

and sent to the web site related to online service provider 2 along with the request. Appropriate

routines are implemented at the said web site to decrypt the user's identification number and

compare it against a list of valid members in order to ensure the validity of the user. (See

abstract; figs. 1-6 and 9; col. 4: 40 to col. 5: 61; col. 6: 65 to col. 7: 55; col. 8: 22-48; col. 10: 1-

16; col. 10: 24-30; col. 10: 50-56; col. 11: 11-43; col. 13: 50-62).

In any event, following a redemption process, redeemed coupon data are transmitted by

the desired retailer or POS, especially a brick and mortar store, to a coupon redemption center 13

where they are electronically read and the user-specific data are recorded in a coupon redemption

database (D/B) 12. Additionally, the user's transaction data including the redeemed coupon data

(redemption data or coupon usage) are provided to the coupon issuers 14 (company, retailer or manufacturer) and coupon distributors 16 of fig. 1 for integration into further marketing analysis in order to provide further targeted coupon packages to the customer. In order words, the coupon issuers 14 or merchants (or coupon distributor 16) of fig. 1 utilize the user-specific data **(coupons deleted, coupon printed and demographic data, user's buying or shopping history, number of times coupons were viewed or requested or selected) along with the redemption data to generate or compile subsequent coupon packages targeted specifically or directed to the user's attention (using redemption data and online demographic inquiries to update the user's virtual coupons or electronic coupons stored in database 40)** (See abstract; col. 5: 23-34; col. 6: 58-65; col. 7: 12-20; col. 7: 36-55; col. 8: 14-21; col. 12: 26-37).

Additionally, the online service provider 2 has means to determine how many times a particular coupon was selected or viewed or requested. Coupon usage data and user's responses to online demographic inquiries are used to provide a coupon of a higher value to the user (col. 13: 24-35).

Finally, and in summary, Barnett discloses an online coupon distribution method or system for enabling a user to view and print at a remote terminal user-specific coupons based on a user profile, the method comprising the steps of:

   (a) storing in a storage device at a central location electronic coupon information pertaining to a group of coupons available;

   (b) receiving a request from a user for access to stored coupon information;

(c) determining if the user is a registered user, and if the user is not registered:

i) transmitting a prompt to the remote terminal to electronically complete a user profile and transmit the user profile to the central location;

ii) receiving and storing a user profile at the central location; and

iii) downloading to the remote terminal a coupon data management software module for managing the printing of coupons, including unique user identification information;

if the user is registered, accessing the stored user profile;

**(d) viewing, by a remote terminal, selected ones of the stored coupons, the selected coupons being based on user-specific information, which comprises user profile information and/or user usage history information;**

(e) receiving at the central location a request to transmit to the remote terminal at least one coupon data file, the coupon data file corresponding to a user selected coupon, the coupon data file comprising various fields, including a redemption amount field and other fields, the redemption amount field being indicative of a discount provided by the coupon, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user; and

(f) transmitting to the remote terminal the at least one coupon data file to enable the user to print a coupon using the coupon data management software module.

See claim 1 of the current reference.

**(Col. 12: 26 to col. 13: 63; col. 10: 15 to col. 11: 11; col. 11: 48-57; col. 9: 35-53; col. 8: 14-21; col. 7: 56 to col. 8: 5; col. 13: 11-35).**

Please consider the entire reference.


**(10) Response to Argument**

On September 17, 2008, the Office mailed a Non-Final Action to the Appellant. On September 29, 2008, the Appellant filed a request for reconsideration, under 37 CFR 1.111, consisting of a claim amendment and arguments. Even before, the Examiner issued a response to the 1.111 reply, Appellant had filed on October 23, 2008 a Notice of Appeal together with an Appeal Brief. In response, the Examiner had asked the Appellant to either render the 1.111 reply null and void to thereby proceed with  the Appeal Brief after updating the said Appeal or withdraw the Appeal and have the 1.111 reply considered instead. By so doing, the Examiner had issued a "defective Appeal Brief" while concluding that <u>the Application was not in condition for Appeal</u> (in view of the confusion).

The Appellant, on January 30, 2009, had filed a reply in the form of a petition to the "defective Appeal Brief" and correctly argued that the Application was in condition for Appeal for the claims had been rejected many times (more than twice) and agreed to "render the 1.111 reply null and void" or simply cancel the 1.111 reply to thereby proceed with the Appeal Brief filed on October 23, 2008 (See page 4 of the said response-3rd paragraph). Furthermore, it appears that the Appellant had elected to rather proceed with the old Appeal Brief, filed on October 17, 2006, since the last Office Action was a response to the filing of the old Appeal Brief. The rest of the Appellant's remarks in the petition is beyond the scope of the Examiner's

Answer. Additionally, the **petition was granted in part, on April 10, 2009,** agreeing with the

Appellant that the Application was indeed in condition for Appeal and the Examiner will proceed

with the Examiner's Answer as shown below.

**Request to reinstate the 10/17/2006 Appeal Brief**

  Contrary to the Appellant's position, the Examiner's response to the 10/17/2006 Appeal

Brief was a restriction, not the last Non-Final Action or pending Action, and the Appellant had

successfully traversed the restriction via a petition and the last Office Action or pending Action

was issued after the restriction was withdrawn. Thus, it appears that the Appellant cannot

reinstate the 10/17/2006 or old Appeal Brief at this point since such a request is not timely.

Arguendo, even if the Appellant could reinstate the old Brief or the request was timely, the

Appellant's response would have failed to address the last (pending) Office Action. In fact, the

old Appeal Brief, as it now stands, does not constitute a proper response, **under 1.111**, to the last

outstanding Office Action mailed on September 17, 2008. Further, the provisions of former 37

CFR 1.193 (b)(2)(i)(ii) or MPEP 1207.04 [R-3] permit the Primary Examiner to re-open

prosecution following the filing of an Appeal Brief and the Appellant to submit a response under

37 CFR 1.111 or to request a reinstatement of the (old) Brief provided that a **Supplemental**

**Brief** accompanies the response (i.e. updating the old Brief), which addresses the new issues

raised by the Examiner in the last Action. Here, the Appellant's request to reinstate the old Brief

does not include a **Supplemental Brief addressing the issues raised** by the Examiner in the last

Action. Therefore, the Appellant's request to reinstate the old Brief is denied since it is not

timely. Even if the request were to be granted, the (old) Brief would have been defective for

failure to address the issues raised by the Examiner in the last Office Action, which is presently

pending. (Former 37 CFR 1.193 (b) (2)(i)(ii)) or MPEP 1207.04 [R-3]). Here, even if the Board

were to agree with the Appellant that the old Brief should have been reinstated, the Examiner

would like to point out that the old Brief would have failed, under 37 CFR 1.111, to address the

last Office Action, which would have not been challenged or traversed in anyway and the

Examiner's Action should have been sustained or maintained.

**Reinstate the 10/23/2008 Appeal Brief**

        Appellant had agreed, as described above, to cancel the 37 CFR 1.111 response, filed on

September 29, 2008, and proceed with the Appeal Brief filed on October 23, 2008 without

updating, as suggested by the Examiner, the said Appeal Brief or including a related

**Supplemental Brief addressing the issues raised by** the Examiner in the last Action and based

on the claims that were pending at the time the Non-Final Action was issued, but not on the

amended claims filed with the September 29, 2008 37 CFR 1.111 response, which was never

considered by the Examiner and subsequently canceled by the Appellant's January 30, 2009

reply to the defective Appeal Brief. Thus, the present Brief (Re. 10/23/2008) including the

arguments is based on those amended claims, which were not considered. Further, the

Appellant's claim amendment did more than clarifying 101 and 112(2) issues, which could have

simplified the issues before the Board. In this case, incorporating the amended claims into the

Brief is said to be improper and the response to the Examiner's Action inadequate. Having said

that, the Examiner's Action was not appropriately challenged or traversed since the Appellant's

remarks based on the amended claims, filed on September 29, 2008, which were never

considered by the Examiner since they were canceled together with the 37 CFR 1.111 response.

In this case, the Examiner's Action should be sustained or maintained for it was never

appropriately traversed or challenged by the Appellant.


## 112, Second paragraph

Here, the Examiner inadvertently reported claim 31 instead of claim 32.

Regarding the 112, second paragraph rejection as being indefinite, the Examiner

completely and respectfully disagrees with the Appellant's remarks since claims 32, 38, 44, 50

and 54 are indeed indefinite, under 35 USC 112 2), for reciting the auxiliary verb **"can"**, which

creates some uncertainty in the claims and the amendment, filed on September 29, 2008, to cure

or overcome the rejection was never entered or considered for the reasons discussed above.

Further, the rejection of claim 57, under 35 USC 112, second paragraph, as being

confusing for reciting a web site (i.e. data per se) in the preamble, while the body of the claim

contains structure or means plus function (Hardware), is deemed proper and the explanation and

definition of web site provided here by the Appellant are not convincing. Although there is a

tendency in the art to incorrectly consider or treat a "web site" as a system or web server (a file

server connected to the Internet), however, a "web site", broadly interpreted, is a collection of

web pages including web pages printed on physical papers or web pages stored in database files.

For example, a webmaster, during a presentation, may show to a client a plurality of printed web

pages representing the client's web site under construction. The plurality of printed web pages

still represents the client's web site. Further, if the collection of related web pages is stored in

database files, then the web site represents at best a collection of files (i.e. data per se). Until a

web site is coupled to a (web) server (file server or central computer), it is simply a collection of

web pages or files. In other words, contrary to the Appellant's contention, a "web site" does immediately represent a "machine" or a computer or structure. Hence, the "web site", as featured in claim, represents at best a collections of web pages or (web page) files (i.e. data per se) and cannot, in itself, include Hardware or structure. Thus, a "web site" (software), which includes structure is said to be confusing.

And the amendment, filed on September 29, 2008, to cure or overcome the rejection was never entered or considered for the reasons cited above.


## 101 Rejection

The rejection of claim 57, under 35 U.S.C. 101 as being directed to a non-statutory subject matter (to a non-functional and non-descriptive material), for reciting a web site (i.e. data per se) in the preamble, while the body of the claim contains structure or means plus function (Hardware), is deemed proper and the explanation and definition of web site provided here by the Appellant are not convincing. Although there is a tendency in the art to incorrectly consider or treat a "web site" as a system or web server (a file server connected to the Internet), however, a "web site", broadly interpreted, is a collection of web pages including web pages printed on physical papers or web pages stored in database files. For example, a webmaster, during a presentation, may show to a client a plurality of printed web pages representing the client's web site under construction. The plurality of printed web pages still represents the client's web site. Further, if the collection of related web pages is stored in database files, then the web site represents at best a collection of files (i.e. data per se). Until a web site is coupled to a (web) server (file server or central computer), it is simply a collection of web pages or files. In other

words, contrary to the Appellant's contention, a "web site" does immediately represent a

"machine" or a computer or structure. Hence, the "web site", as featured in claim, represents at

best a collections of web pages or (web page) files (i.e. data per se) and cannot, in itself, include

Hardware or structure. Thus, a web site by itself is a collection of web pages (files), i.e. data per

se, which does not necessarily imply or involve a web server or a database (or any kind of

structure). To this end, the recited web site is data per se, which does not belong to any well

defined statutory class (.e.g. a method, a system, an apparatus, an article of manufacture….).


**Prior Art Rejection**

      With respect to independent claim 32, as shown on page 13 of the Brief, although the

Appellant admits that Barnett teaches "a system for delivering incentives over the Internet" and

"a web site for providing purchasing incentives from multiple sources", however, the Appellant

appears to disagree that Barnett discloses "a consumer purchase history database based on

consumer online shopping activity" and points out that "the Examiner refers to Barnett's

consumer database file 42, user's buying history profile, and the user's demographic data at the

bottom half of page 5" to show the teaching or equivalent of a "consumer purchase history

database based on online shopping activity" (See page 14 of the Brief). Here, the Examiner

maintains that Barnett discloses the argued limitation. First, Barnett discloses a system for

delivering incentives or electronic coupons to customers over the Internet via a website, wherein,

upon redemption by a store during a purchase or shopping transaction, including offline and

online transaction or activity (via online shopping mall), (offline and online) <u>transaction data</u>

(broadly interpreted include redeemed coupon data and other related data such as the matched or

required product-purchased data) are supplied to the coupon issuers and distributor for

integration into marketing analysis for preparing future targeted incentives or electronic coupons

to (identified) customers based on the offline and online purchase/shopping activity (based on

offline and/or online shopping activity or purchase history) (See abstract; col. 8: 14-22; col. 11:

30-43)**.** First, in the alternative, or in addition to printing and redeeming coupons offline or at

retail stores 10, the coupons may be redeemed electronically by sending the coupon data (in

printable version) from the user's personal computer 6 local memory, via the data

communication interface 20, back to the online service provider 2 for online storage and later

retrieval during a redemption. This is especially useful in the "electronic shopping mall"

environment now found in many online services (broadly interpreted, the electronic coupons,

stored by the online service provider 2 system, are redeemed online via online shopping mall).

The electronic coupon data could also be routed via the data communications interface 20 to a

retail store 10 of fig. 1 where the user will be shopping, where the coupon data is held in a buffer

pending purchase by the user of the matching or required product (redeeming electronic coupons

offline). (col. 11: 30-43). **Second, and more importantly, coupon packages file 40 of fig. 6**

**comprises electronic coupon data and other types of advertising materials supplied by the**

**various coupon issuers/sources 14 through the coupon distributor 16. Individual users'**

**coupon data packages are drawn from this file (directory or folder comprises a plurality of**

**files) based on demographic data and historic buying profiles (including online or offline**

**shopping activity that involves redemption) stored in the demographic data file 42 (user's**

**purchase history is based at least on online shopping/purchase activity, including the**

**purchase of matched or required products during transactions or redemption of electronic**

**coupons, via an online shopping mall-Col. 8: 14-22).**

In addition, still regarding the argued online shopping activity, Appellant states that

"notably absent is any conception of association of all product identification data associated with

a purchase being stored in association with a consumer identification received during the

purchase, transmission of that data to the coupon distribution center, and use of that transaction

data by the coupon distribution center uses for marketing analysis". However, the Examiner

notes that the concept of "associating all product identification data with a purchase being stored

in association with a consumer identification received during the purchase…" was presented in

the 1.111 amendment, filed on September 29, 2008, which was not entered by the Office,

subsequently canceled by the Appellant, in the January 30, 2009 reply in favor of the present

Brief, and was never considered by the Examiner. On pages 14-15, Appellant goes into great

details explaining the argued limitation or present system with respect to the specification. It

appears here that the Appellant is improperly reading specific limitations from the specification

into the claimed invention. Once again, the Examiner wants to remind the Appellant that

although the Examiner considers the claims in view of the specification, however, specific

limitations from the specification are not being read into the claims (See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Further, on page 16, Appellant mentions new dependent claims 92-97 for disclosing

additional features. Here, the Examiner notes that claims 92-97 were presented in the 1.111

amendment, filed on September 29, 2008, which was not entered by the Office, subsequently

canceled by the Appellant, in the January 30, 2009 reply in favor of the present Brief, and was

never considered by the Examiner. With respect to pages 17-19, the Examiner offers no response

to the materials featured therein since they do not directly impact prosecution of the Instant

Application.

   Still regarding claim 32, at the bottom of page 19 and beginning of page 20 of the Brief,

Appellant submits that **the claimed Database Storing Email Addresses of consumers** and the

Examiner asserts that Barnett discloses claim 32's " a consumer database which <u>stores e-mail</u>

<u>addresses of consumers</u> for identifying consumers by their e-mail addresses" (page 6 of the

Office Action). That is, continues the Appellant, the Examiner incorrectly asserts that Barnett

discloses a database storing email addresses of consumers since Barnett contains only one

reference to email. In response, the Examiner wants to point out that claim 32 that was examined

during the last Office Action simply recited **"a consumer database which can identify**

**consumers by an e-mail addresses"** **(i.e. the e-mail address is used as an ID) and the argued**

**limitation was never considered or examiner by the Examiner**. Barnett, as the Appellant

seems to agree, discloses using an e-mail address as an ID or identification number to identify or

validate a consumer's transaction or request (e.g. a request for a coupon stored in the online

service provider 2 system memory), thereby performing the transaction in a secure manner **(col.**

**13: 50-63).** Further, the Examiner notes that "**the claimed Database Storing Email Addresses**

**of consumers"** was presented in the 1.111 amendment, filed on September 29, 2008, which was

not entered by the Office, subsequently canceled by the Appellant, in the January 30, 2009 reply

in favor of the present Brief, and was never considered by the Examiner.

   Still with respect to claim 32, on page 21 and first paragraph of page 22 of the Brief

under "The claimed Two Databases), Appellant submits that **the Examiner admits that Barnett**

**fails to disclose claim 32's claimed two databases, the claimed "consumer purchase history database" and the claimed "consumer database" (page 7 of the last Office Action)**.

Specifically, continues the Appellant, "the Examiner statement at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively and to give respective users and/or operators access rights to the stored information." establishes that the examiner considered the two database files recitation, a limitation, **and yet the office action does not assert that Barnett discloses that limitation**". **Still continues the Appellant, "the Examiner's failure to assert Barnett discloses two database files** and then relying upon the alternative theory at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively" **to suggest the claimed database structure is an admission that the Examiner does not believe that Barnett discloses the claimed two database files"**.

In reply, the Appellant's various statements as noted above are confusing. Although the Appellant states that **the Examiner admits that Barnett fails to disclose claim 32's <u>claimed two databases</u>, the claimed "consumer purchase history database" and the claimed "consumer database" (page 7 of the last Office Action),** however, the Appellant also points out that **the Office Action does not assert that Barnett discloses that limitation or so-called "claimed two databases".** Indeed, the Office Action clearly mentions that, regarding at least claim 32, that although **Barnett discloses that a user's demographic information including the user's identifying data, e.g. unique code, e-mail address and so on, and the user's buying history (online/offline) is stored in database file 42 of fig. 6 (consumer database) and that the user's requested coupon data are electronically transmitted to the user's computer**

**6 of fig. 1 where they can be printed, however, <u>Barnett does not expressly teach a consumer</u>**

**<u>purchase history database separately storing the buying history (online/offline), nor does</u>**

**<u>he mention e-mailing coupon data or purchase incentives to the user for subsequent</u>**

**<u>printing.</u>** Here, it is clear from the above passage that Barnett teaches an integrated database

(file) or consumer database 42 of fig. 6 storing the user's demographic data and the

(online/offline) buying history, but not two databases (database files), namely a purchase history

database (directory/file) storing online/offline buying history or purchase history and a consumer

database (database directory/file) for identifying consumers by e-mail addresses.

　　　　Additionally, continues the Appellant on page 22 of the Brief, "the Examiner states that

an "integrated database file 42 of fig. 6 or two separate database files respectively is a matter of

desires or choice, which does not impact the functionality or utility of the method or system."

and "This is an admission that the examiner does not recognize the utility of two separate

database files, which is probative of the fact that one of ordinary skill in the art would not

recognize the value of two separate database files, and therefore is probative of the fact that there

is no motivation to modify what Barnett and Shane disclose to be what claim 32 defines". In

response, the Examiner submits that Barnett discloses an integrated consumer database file 42

containing the consumer's data and the buying history. Even if storing the different types of data

into a single database (file) presents a challenge to computer programmers, as the Appellant

suggests, Barnett seems to recognize that it can be done and it is well within the level of skills of

a computer programmer. That is why, to appreciate the Appellant's point here, an ordinary

skilled artisan would have been motivated at the time of the invention to store the user's or

consumer's data in one database (file) and the buying history in another database (file), thereby

bypassing or eliminating the degree of complexity or difficulty related to storing the different

types of data into a single database (file). It appears also that Barnett meant to refer to a database

directory 42, comprising a plurality of files for storing different types of data, as opposed to a

database file 42 for storing the different data for the concept of directory structure, related to an

Operating System, or the manner in which data are organized in a Hard Drive (database) for easy

manipulation and retrieval was well understood by computer users and computer technicians at

the time the present Application was filed. Having said that, the Examiner's comments that using

one integrated database file 42 instead of two separate database files for storing the different type

of data is matter of desires is based on Barnett's disclosure that the different data can be stored in

a single database file 42 and Barnett's never eliminates the need for improvement in his system

such as the use of two different databases or database files for storing the different types of data.

Further,  what is at stake here is that the Examiner has corrected recognized, contrary to the

Appellant's contention, the deficiency in Barnett and has compensated for such deficiency via

the use of two separate databases or two separate database files as described in the Office Action

and acknowledged by the Appellant.

Still with respect to "The Claimed Two Database" remarks, as shown on page 23 of the

Brief, Appellant points out that memory limitations are also relevant and combining data files is

generally impacted by the physical memory size (number of bits of storage), logical size

constraints (number of bits in reference to an operating system) and hierarchical limitations

(number of data objects at any level that may be efficiently referenced, such as the number of

files an folder). However, the Examiner notes, as the Appellant seems to herein recognize, that

the size of a directory/folder (i.e. how large a directory can be), containing a plurality of files

and/or one or more subdirectories (folders) having therein one or more files, and the size of a file

are limited by the Operating System (OS) being used or depend upon the Operating System (OS)

being used, as understood by those having ordinary skills in the art (Such as a computer

technician, a System Engineer or a System Integrator).

       Moreover, in another aspect of claim 32, Appellant submits that, on page 6 of the Office

Action, that the Examiner expressly admits that **Barnett does not disclose claim 32's "means**

**for delivering purchasing incentives to consumers by e-mail**."

From the end of page 6 to the top of page 8 of the Office Action, adds the Appellant, the

Examiner discusses Shane, **but the Appellant cannot discern the relevance of the Examiner's**

**comments**. Further, Appellant points out, inter alia, **that Shane discloses that targeted e-mail**

**lists are not yet available for advertisers** (col. 1: 31-37) and concludes that Shane **does teach**

**direct one to one communication via e-mail**, **but also generally teaches away from using**

**email for marketing.** Here, the Examiner is having trouble following the Appellant's rationale.

First, based on Appellant's own admission, the fact that **Shane discloses that targeted e-mail**

**lists are not yet available for advertisers** does not necessarily mean that e-mail lists cannot be

used for advertising or marketing or Shane himself is against using e-mail lists for marketing or

advertising. Second, the purpose of the **direct one to one e-mail communication** of Shane is to

conduct a marketing (advertising) or a promotional campaign. To this end, Shane cannot in

anyway teach away from using e-mail communication or delivery for marketing for the purpose

of the e-mail (mail) system, as taught by Shane, is to conduct a marketing campaign via regular

mail or e-mail or in conjunction with regular mail or e-mail.

Finally, on page 25 of the Brief under "Rationale for Modifying Barnett is Unclear",

Appellant states "that the Examiner asserts, from the bottom of page 8 to the end of page 9 of the

Office Action, **that Shane suggests modifying Barnett to record the** user's demographic

information including the user's identifying data, e.g. unique code, e-mail address and so on, in a

database file 42 of fig. 6 and the user's buying history (online/offline shopping activity) in

another and separate database or database file and to enable two different and independent

operators or authorized employees, with appropriate rights, to access the respective databases or

database files to separately maintain and analyze the data contained therein in order to generate

individual user's profile information, based on the collected demographic data and buying history

respectively, which is used to produce a merged or combined user's profile useful in crafting

targeted coupon data or purchase incentives that are sent to the specific user via e-mail, wherein

the content of the e-mail is subsequently printed at the user's computer 6 of fig. 1 using a printing

device coupled thereto, thereby ensuring that the user's (combined) profile, generated from data

contained in the database files (consumer database and history database respectively) and used

by the issuers or sources to prepare customized coupon packages or purchase incentives e-mailed

to the specific user, is accurate and independently produced by two different and independent

operators or authorized employees before the result of the independent analyses is merged or

combined to form the user's profile, while pro-actively targeting the user by e-mailing

customized coupon data packages to the user, based on the combined profile, without the user's

intervention or without the user visiting the online service provider 2 web site to view or request

the coupon data packages therefrom". **Having said that, the Appellant contends that he**

**cannot discern the meaning of the foregoing or above statement, other than that the**

**examiner asserts that the applied prior art in combination suggests claim 32.** In response, it should herein be noted that, contrary to the Appellant's contention, the Examiner never states that **Shane expressly suggests modifying Barnett to record the ...**It appears here that the Appellant is of the opinion that the motivation to combine must come from the prior art itself**, while ignoring general knowledge commonly available to an ordinary skilled artisan.** The motivation to combine can be based on general knowledge commonly available to an ordinary skilled artisan (especially after KSR). Further, the Examiner agrees with the Appellant that the purpose of the above statements is to **assert that the applied prior art in combination suggests claim 32 or the claimed invention.**

In the end, the Examiner's Action should be maintained for the Appellant's remarks are based in part on claim limitations that were never considered or examined by the Examiner as described above.

### (11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this Examiner's Answer are referenced herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/J. J./
05/23/09

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